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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/840,730	04/23/2001	Michael R. Hufford	IVQ-003RCE	4534

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EXAMINER

CASLER, TRACI

ART UNIT	PAPER NUMBER
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3629

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/26/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

09/840,730

Applicant(s)

HUFFORD ET AL.

Examiner

Traci L. Casler

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10/27/2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This action is in response to papers filed on October 27, 2006.

Claims 1, 22, 33, 42, 47 and 51 have been amended.

Claims 1-51 are pending.

Claims 1-51 are rejected.

#### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 27, 2006 has been entered.

#### ***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-31 and 33-41 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6,682,440; Karidis et al. Flexible Interface Portable Computing Device. Hereinafter referred to as Karidis.

3. As to claims 1, 22, 26 and 51 Karidis teaches a system and apparatus with

- Paper form for recording data with an integrated electronic instrument that generates a record regarding the use of the paper diary(form).(C. 13 I. 35-40).
4. As to claims 2 and 23 interface for transferring records(C. 15 I. 41-47).
  5. As to claims 3-7, 10-11, 28 and 32-37 Karidis teaches a system and apparatus with several options for sensors that detect use. (C. 7 I. 51-53 & C. 14 I. 51-53).
  6. As to claims 8, 29-31 and 34-39-41 Karidis teaches time and date stamping a record when detection is made by recording unit(C. 10 I. 17-20)
  7. As to claim 9 Karidis teaches superimposing the paper over the recording unit(C. 10 I. 1-5).
  8. As to claim 12 Karidis teaches a pen to be used to allow a user to write on paper and contains a sensor(C. 1 I. 27-29).
  9. As to claim 14 Kardis teaches storage for the electronic records(C. 6 I. 27-29).
  10. As to claims 15-18 teaches the recording unit detecting use and date stamping(C. 10 I. 17-20).
  11. As to claim 19 Karidis teaches the electronic instrument visible(Fig. 13).
  12. As to claim 20 Karidis teaches a GI display(C. 6 I. 1-2).
  13. As to claim 21 Kardis teaches the recording unit superimposed by the paper(covertly connected)(C.9 I. 59).
  14. As to claim 24 Karidis teaches a cable connection(C. 6 I. 32-34).
  15. As to claim 25 Karidis teaches device comprising a laptop(C. 7 I. 3-5).
  16. As to cliam 27 Karidis teaches the paper in communication with recording unit(C. 10 I. 17-20).

17. As to claim 33 Karidis teaches a method of detecting an event RELATED to data entry onto paper with an electronic instrument incorporated it diary(C. 15 I. 35-40) and capturing and storing CHARACTERISTICS of the related event(C. 10 I. 17-20).

***Claim Rejections - 35 USC § 103***

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

20. Claims 47-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,362,440 Karidis et al. Hereinafter referred to as Karidis.

21. As to claims 47 Karidis teaches method of detecting an event RELATED to data entry onto paper with an electronic instrument incorporated it diary(C. 15 I. 35-40) and capturing and storing CHARACTERISTICS of the related event(C. 10 I. 17-20).

Karidis fails to teach the data that is being entered/recorded or tracked as clinical trial

data. However, it would be obvious to use the recording/computing device record any type of data that is pertinent to ones work or research area.

22. As to claim 48 Karidis teaches creating an electronic record(C. 10 I. 17-20).

23. Claims 42-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,362,440 Karidis as applied to claims 47-48 above, and further in view of Non-patent literature article "Diary keeping in asthma: comparison of written and electronic methods." Hyland, et al. Hereinafter referred to as Hyland.

24. As to claim 42 Karidis teaches detecting an event RELATED to data entry onto paper with an electronic instrument incorporated it diary(C. 15 I. 35-40) and capturing and storing CHARACTERISTICS of the related event(C. 10 I. 17-20). Karidis fails to teach comparinig the electronic record with what the user wrote on paper. Hyland teaches a comparison of electronic and pencil diaries.(Abstract). It would have been obvious to one of ordinary skill in the art at the time of invention to combine Hyland with Karidis as the electronic time coded diary provides an more accurate quality review of data entry, but the paper form is more desirable, comfortable or normal to the user.

25. As to claim 43-44 Karidis teaches time and date stamping a record when detection is made by recording unit(C. 10 I. 17-20)

26. As to claims 45-46 Karidis teaches time and date stamping a record when detection is made by recording unit(C. 10 I. 17-20). Karidis fails to teach validity of data based on time. However, Hyland teaches validity of a diary being completed the actual day rather than in retrospect(Pg. 1 C. 2.). It would have been obvious to one of ordinary

skill in the art at the time of invention to combine Hyland with Karidis to be able to determine accuracy of data.

***Response to Arguments***

27. Applicant's arguments filed October 27, 2006 have been fully considered but they are not persuasive.

28. Applicant argues that Karidis is not incorporated into the diary and that it is merely a recording device. However, applicant explains a dairy in the specification as anything to take notes or entries. Therefore, given a recording device with paper used for writing on is an equivalent. Applicant additionally argues that incorporation makes the device unobtrusive from the user. The examiner notes that in the summary and background of art Karidis discusses how it is advantages for the paper over the electronic recording device as it is what the user I familiar with and can be used to take notes in a discrete and still be saved for manipulation and distribution. Furthermore, the examiner notes though the applicant is arguing the "diary" unobtrusive yet they still claim the device is visible to the user. (Claim 19).

29. As to applicants arguments regarding the Hyland reference. The applicant argues Hyland's records are not generated from writing on paper. However, the examiner notes Hyland is used for the comparison aspect of records, not for the generation of the records.

30. Applicant argues the combination improper because Karidis ia a computer log of Hyland. The examiner notes Karidis teaches an electronic log with a paper form used

to make entries not merely just an electronic log. Therefore, applicants arguments support examiners combination of references in that Karidis' log could be used to replace Hyland two logs and still maintain integrity to the research being done.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traci L. Casler whose telephone number is 571-272-6809. The examiner can normally be reached on Monday-Thursday 6:00 am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



*[Handwritten signature]*  
Traci L. Casler  
Examiner  
Art Unit 3629